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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,128

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Reiner Fischer

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EXAMINER

BUCKLEY, AUDREA

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

09/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,128	Applicant(s) FISCHER ET AL.	
	Examiner AUDREA J. BUCKLEY	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/25/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, represented by claims 1-5, 7-9, and 12, in the reply filed on 7/14/2009 is acknowledged. The traversal is on the ground(s) that the invention maintains unity. This is not found persuasive because, as outlined in the office action of 6/16/2009, and in accordance with PCT Rule 13.2, the three groups lack a common special technical feature which defines a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. Therefore, since the special technical feature of Groups I-III is the oil based suspension concentrate according to Formula I', and this composition is known, the claims are not so linked within the meaning of PCT Rule 13.2 so as to form a single inventive concept, and unity between Groups I-III is broken.

The restriction requirement is still deemed proper and is therefore made FINAL.

Although Applicant makes no arguments against the requested election of species, this requirement is withdrawn as no search and examination burden argument can be maintained.

Priority

This application is a 371 of PCT/EP05/02294, filed 03/04/2005 and claims priority to foreign application 102004011006.9, filed in Germany, on 3/6/2004. The corresponding documents have been submitted and are made of record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Turberg *et al.* (US 2005/0214336 A1, which was filed internationally as WO 2003/086075, published 10/23/2003).

The formulation comprising a compound of formula (I') as instantly claimed previously was disclosed by Turberg *et al.* (see page 2, column 1, [0005]-[0030]) wherein penetrant agents (page 8, column 2, [0192]), vegetable oils (page 8, column 2, [0180]; page 9, column 1, [0195]), surfactants including nonionic ones (page 9, column 1, [0200]), and optional additives including antioxidants and colorants (page 8, column 2, [0187]-[0190]) are included. For emphasis, the compound of formula (I') was previously taught wherein the prior disclosure included both the core structure and the exact, specific substituents as instantly claimed (see page 2, column 1, [0005]-[0030]).

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As all of the features and limitations of the instant claims previously were taught, the composition as claimed was anticipated by the teachings of Turberg *et al.* and therefore lacks patentability.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-5, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turberg *et al.* (US 2005/0214336 A1, which was filed internationally as WO 2003/086075, published 10/23/2003) as applied to claim 1 above.

As to claims 2-5, each of the named substituents of formula (I') as defined in claim 1, were taught by Turberg *et al.* For example and as to claim 5, the most limited of these claims, the identities of "V" and "A and B together" previously were defined by Turberg *et al.* (see page 1, column 2, [0015]-[006]).

Turberg *et al.* does not limit the disclosure to one combining these specific variables as in formula (I').

As to claim 9, Turberg *et al.* disclose an active agent presence of preferably 1.0-40% by weight (see page 8, column 1, [0170]), where the instant claim limits this component to an amount between 5 and 30% by weight.

Turberg *et al.* do not quantitatively limit each of the additional components in the composition.

MPEP 2144.05 addresses overlapping ranges of formulation components as these ranges relate to patentable subject matter:

In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d

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257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Therefore, since an overlapping range of analogous active agent (represented by formula (I')) presence had been taught, one of ordinary skill in the art at the time the invention was made would have been motivated to implement this active agent in a similar quantity such as that in instant claim 9 and reasonably would have expected continued success from this implementation.

As to claim 12, Turberg *et al.* teach adjuvant components serving as extenders and/or surface-active reagents (see page 8, column 1, [0173]-[0175]).

Where each of these components was disclosed by the prior art of Turberg *et al.*, one of ordinary skill in the art at the time the invention was made would have been motivated to look to the teaching of Turberg *et al.*, especially since the prior art discloses these compositions for the systemic and nonsystemic control of parasites in animals using the exact same phenylketoenol derivatives as instantly claimed. Further, in order to optimize an analogous composition for an analogous function, one of ordinary skill in the art at the time the invention was made would have been motivated to perform routine optimization procedures, with respect to the variable derivatives of the core molecule of Formula (I') and with respect to the concentration of the formulation components. Further still, the skilled artisan would have expected continued success based on the prior successes of phenylketoenol derivatives as taught by Turberg *et al.*, wherein any of the combinations of substituents were taught in a phenylketoenol derivative effective for parasite control.

For these reasons, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have selected substituents and formulation components of claims 2-5, 9, and 12 based on the teachings of Turberg *et al.*

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turberg *et al.* (US 2005/0214336 A1, which was filed internationally as WO 2003/086075, published 10/23/2003) as applied to claims 1-5, 9, and 12 above and further in view of Hoffarth (US 5,705,476).

Turberg *et al.* do not teach alkanol alkoxyate penetrating agents as components in the parasite control composition.

Nonetheless, Hoffarth disclose low-foaming wetting agents consisting of various alkoxyated alcohol mixtures for applications such as formulating crop protection agents, for example (see abstract, in particular; see also, column 1, lines 10-16). Further, Hoffarth teach various alkoxyate species such as formula (Ia), illustrated in column 8, claim 1. One of ordinary skill in the art at the time the invention was made would have been motivated to look to the teachings of Hoffarth in order to determine an effective wetting agent or penetrant identity. As to instant claims 7 and 8, the exact alkanol alkoxyate formulas named are included in the range of alkanol alkoxyates previously taught.

Since Hoffarth previously had demonstrated successful wetting agents having the structure of formula (Id) of the instant claims, one of ordinary skill in the art at the

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time the invention was made reasonably would have expected continued success from implementing these specific wetting agents. It would have been obvious at the time the invention was made to implement these specific wetting agents in the analogous oil based suspension concentrate as instantly disclosed.

For this reason, the content of instant claims 7 and 8 would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AUDREA J. BUCKLEY whose telephone number is (571)270-1336. The examiner can normally be reached on Monday-Thursday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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